

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application. Claims 1-13 are currently pending in this application. No new matter has been added by way of the present amendment. For instance, claims 1 and 6 have been amended to more clearly recite the features of the present invention. New claim 13 is supported by previously presented claim 5. Accordingly, no new matter has been added.

At the outset, the present application is believed to be in condition for allowance. Entry of the accompanying amendment is requested under 37 C.F.R. §1.116, as the amendment does not raise any new issues which would require further search and/or consideration by the Examiner. Furthermore, Applicants request entry of this amendment in order to place the claims in better form for consideration on Appeal.

In view of the amendments and remarks herein, Applicants respectfully request that the Examiner withdraw all outstanding rejections and allow the currently pending claims.

Issues Under 35 U.S.C. 112, second paragraph

Claims 1-12 stand rejected under 35 U.S.C. 112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. Applicants respectfully traverse.

Specifically, the Examiner asserts that the limitation “the whole surface” in claims 1 and 6 lacks antecedent basis. Claims 1 and 6 have been amended to more clearly recite the features of the present invention and so as to correct the issue identified by the Examiner. Accordingly, this rejection is moot.

Reconsideration and withdrawal of this rejection are thus respectfully requested.

Issues Under 35 U.S.C. § 102(b)

The Examiner maintains the rejection of claims 1 and 3-4 under 35 U.S.C. §102 (b) as being anticipated by Ducker et al. (U.S. 5,938,649) (hereinafter Ducker '649). Applicants respectfully traverse.

The Examiner asserts that Ducker '649 discloses a diaper comprising a liquid impermeable back outer layer sheet, an absorber fixed on the outer layer sheet and a gather portion having a flexible elastic member formed on a predetermined position. The Examiner further asserts that Ducker '649 teaches the application of a water-soluble skin care agent on a surface to be contacted with the skin of the wearer and an oily skin care agent "applied directly on the water-soluble skin care agent." Moreover, the Examiner contends that "the manner in which the surfactant and agents are applied to the article is considered as product by process limitations which do not patentably distinguish the claimed invention from the prior art."

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of anticipation. For anticipation under 35 U.S.C. §102, the reference must teach each and every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993). To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present". *In*

re Robertson, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999). The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Id.*

The present invention is directed, *inter alia*, to an absorbent article wherein a water-soluble skin care agent and an oily skin care agent are applied on a surface of the article. In the absorbent article of the present invention, the oily skin care agent is applied on a predetermined region on which a water-soluble skin care agent is applied. The water-soluble skin care agent is applied on an **entirety of the surface** to be contacted with the skin of the wearer of the gather portion (emphasis added). Further, the oily skin care agent is applied directly **on the water-soluble skin care agent** (without the need for auxiliary agents), so that at least a portion of the oily skin care agent is transferred to the skin of the wearer before the water-soluble skin care agent is transferred (emphasis added).

Applicants respectfully submit that Ducker '649 fails to implicitly or explicitly teach an absorbent article as presently claimed. Ducker '649 specifically discloses that aloe vera is used in combination with a lubricant. Moreover, Ducker '649 further discloses that, in order to alleviate spoilage concerns, the aloe vera is mixed with a relatively waterless lubricant (see, e.g., col. 5, lines 37-42; see also col. 7, lines 8-11).

Clearly, Ducker '649 discloses that the oily skin care agent and the water-soluble skin care agent are mixed or blended together. Thus, Ducker '649 cannot possibly disclose an absorbent article wherein a water-soluble skin care agent is applied on an **entirety of the surface** to be contacted with the skin of a wearer of the gather portion and an oily skin care agent is applied **directly on the water-soluble skin care agent** (emphasis added).

Evidently, Ducker '649 does not implicitly or explicitly disclose an absorbent article as claimed, and thus fails to anticipate the same. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Issues Under 35 U.S.C. §103(a)

The Examiner maintains the rejection of claim 2 under 35 U.S.C. §103(a) as being obvious over Ducker '649. Additionally, the Examiner maintains the rejection of claims 5-9 under 35 U.S.C. §103(a) as being obvious over Ducker '649 in view of Hoshino et al. (U.S. 6,685,953) (hereinafter Hoshino '953) further in view of Ptchelintsev et al. (U.S. 5,834,513) (hereinafter Ptchelintsev '513). Applicants respectfully traverse.

The Examiner asserts that the difference between Ducker '649 and the present invention is "the provision that the diamide formula is specifically as claimed." The Examiner relies on Hoshino '953 and Ptchelintsev '513 to overcome this deficiency.

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Additionally, there must be a reason why one of ordinary skill in the art would modify the reference or combine reference teachings to obtain the invention. A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). There must be a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed

new invention does. *Id.* The Supreme Court of the United States has recently held that the "teaching, suggestion, motivation test" is a valid test for obviousness, albeit one which cannot be too rigidly applied. *Id.* Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.*

As noted above, Ducker '649 fails to teach an absorbent article wherein a water-soluble skin care agent is applied on **an entirety of the surface** to be contacted with the skin of a wearer of the gather portion, and wherein an oily skin care agent is applied **directly on the water-soluble skin care agent** (emphasis added). The secondary references cited by the Examiner fail to cure these deficiencies.

Hoshino '953 is directed to external preparation compositions comprising a diamide derivative. Hoshino '953 does not disclose the addition of this derivative to absorbent articles, or the combination of this composition with a water-soluble skin care agent.

Ptchelintsev '513 is directed to compounds used for treating skin conditions. Ptchelintsev '513 does not disclose the addition of these compounds to absorbent articles, or the combination of these compounds with a water-soluble skin care agent.

Clearly, the cited references fail to teach or suggest each and every limitation of the present invention. Moreover, Applicants submit that one skilled in the art would not have been motivated to modify the absorbent article of Ducker '649 as proposed by the Examiner. As is known in the art, it is difficult to mix water soluble skin care agents and oily skin care agents without a surfactant, emulsifying agent and/or shear force. Thus, one skilled in the art would not have been motivated to modify the Ducker article.

Reconsideration and withdrawal of this rejection are thus respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and objections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

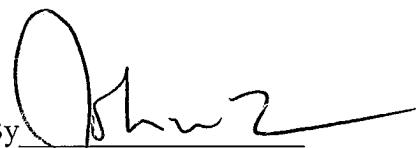
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey, Reg. No. 32,881 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.147; particularly, extension of time fees.

Dated:

MAR 27 2009

Respectfully submitted,

By 

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